

REMARKS

Claims 1, 3-6, 8-11, 13-16, 18-21, 23-26 and 28-31 are pending in the present application. By the present action, claims 1, 11, 21, and 31 are amended and claims 2, 12, and 22 are cancelled. Reconsideration of the claims is respectfully requested.

I. Interview

The examiner is thanked for her time in reviewing the Supplemental Amendment, submitted at approximately the same time as the current office action was being sent. The undersigned agent has requested an interview regarding the amendments and arguments submitted herewith. If such an interview has not been held when the examiner picks this response up for consideration, the Examiner is requested to contact the undersigned agent to discuss this application.

II. 35 U.S.C. § 102, Anticipation: Claims 1-2, 9, 11-12, 19, 21-22, and 29

The examiner has rejected claims 1-2, 9, 11-12, 19, 21-22, and 29 under 35 U.S.C. § 102(e) as being anticipated by Siegel (U.S. Patent Publication No. 2002/0077923) (hereinafter "Siegel"). This rejection is respectfully traversed.

It is noted that dependent claim 2, 12, and 22 have been cancelled and their subject matter incorporated into their respective independent claims. The rejection of these claims is now moot.

The independent claims have been amended to more clearly recite the invention.

Representative claim 1 now recites,

1. (Currently amended) A computer-implemented method of matching a buyer and a seller of goods; the method comprising:
 - receiving, at an online site, a plurality of registrations, wherein each registration includes a universal product code for a respective item, an identification of the respective user, and a buy/sell indicator that indicates whether the respective user is a seller or a buyer for the respective item;
 - when a first registration of the plurality of registrations is received, searching a database containing the plurality of registrations for a complementary match, wherein the complementary match must contain a universal product code that is identical to the universal product code of the first registration and a buy/sell indicator that is opposite to the buy/sell indicator of the first registration; and

responsive to identifying a complementary match, notifying the user of the match.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983).

Siegel does not anticipate the claims, as Siegel does not show the step of *receiving, at an online site, a plurality of registrations, wherein each registration includes a universal product code for a respective item, an identification of the respective user, and a buy/sell indicator that indicates whether the respective user is a seller or a buyer for the respective item.* Further, Siegel does not meet the limitation of *wherein the complementary match must contain a universal product code.* Siegel is directed to a merchant website at which a user can obtain accessories for a given item. Siegel would not allow other sellers access to the site, as this would be counter-productive to the purpose of Siegel, which is to sell items to the users who present at the site. Further, while Siegel mentions a universal product code (UPC), it is for the purpose of locating accessories or related items for the item mentioned in the UPC. Siegel does not allow the user to specify a UPC of an item that the user desires to purchase. Thus, Siegel does not meet the recitations of this claim and does not anticipate the claimed invention. Claims 11 and 21 are rejected for the same reasons as claim 1, so Siegel does not anticipate these claims either.

Dependent claims 9, 19, and 29 each depend from one of claim 1, 11 or 21 and are thus allowable for the same reasons as given above. Further these dependent claims provide additional recitations that distinguish over the art. Exemplary claim 9 recites *wherein the registration information includes a description of the condition of the item.* The rejection states, regarding this claim,

Siegel discloses a method and corresponding system and computer program product for performing online product registration ... wherein the transactional match contains complementary offer terms to offer terms of the registering user

(p.1, 5-11 and p.3, 30-35); and registration information includes a description of the condition of the item (p.1, 5-11 and p.3, 30-35—brand new).¹

In claim 9, the condition of the item being registered is important, because it can affect the price that will be agreed on between buyer and seller. Siegel does not show the recited element, because Siegel is not dealing with the same type system.

Siegel discloses,

a method and apparatus... for performing on-line registration over an open computer network (e.g., the Internet) of an item previously purchased by a customer. ...The registration form requests customer information such as an identifier identifying the purchased item. Upon receiving a completed registration form from the customer, a database is searched to generate a list of purchasable items.²

In Siegel, the item being registered is not an item to be bought or sold; instead, by registering the item, the user is indicating that he wants to purchase additional items usable with the registered item, such as accessories. There is no need to know the condition of the previously purchased item and Siegel does not disclose receiving a condition of the registered item. The rejection is overcome for these claims.

Therefore, the rejection of claims 1, 9, 11, 19, 21, and 29 under 35 U.S.C. § 102(e) has been overcome.

Furthermore, Siegel does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. Siegel only wants buyers to visit its site and does not accept registrations from other sellers. To modify Siegel to accept other sellers would go against the principal reason that Siegel maintains the site, which is to sell additional products to the users. Thus, there is no motive to so modify Siegel.

III. 35 U.S.C. § 103, Obviousness: Claims 3-4, 10, 13-14, 20, 23-24, and 30

The examiner has rejected claims 3-4, 10, 13-14, 20, 23-24, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Siegel in view of Dutta (U.S. Patent Publication No. 2002/0073008) (hereinafter "Dutta"). This rejection is respectfully traversed.

It is noted that although the office action states that the rejection was *set forth in the previous office action*³, Siegel is newly cited, so previously setting forth this rejection would

¹ Office action of 06/13/2005, page 3, first paragraph, underlining added

² Siegel, abstract

³ Office action of 06/13/2005, page 4, top of page

have been impossible. Applicants assume that the Examiner meant to state that the specific elements shown by **Dutta** were discussed in the previous action. Additionally, there are at least the following three problems with this rejection.

- a) All of the claims in this rejection are dependent claims. Since their respective independent claims have been shown to be allowable, these claims are also allowable.
- b) Further, it is noted that all of these claims contain the limitation *wherein the registering user is a seller*. Although no motivation has been set forth for combining these references, Applicants assert that one would not seek to combine these two references. **Dutta** is interested in bringing together multiple buyers with multiple sellers, while **Siegel** is interested only in attracting buyers. It would have been against the interests of **Siegel** to allow other sellers to participate.
- c) It is additionally noted that **Dutta** is assigned to IBM Corporation, as is the present application. Additionally, **Dutta** was originally rejected under 102(e). According to U.S.C. 103(c),

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Thus, **Dutta** cannot be used in a 103 rejection against the current application.

Therefore, for all of the above reasons, the rejection of claims 3-4, 10, 13-14, 20, 23-24, and 30 under 35 U.S.C. § 103(a) has been overcome.

IV. 35 U.S.C. § 103, Obviousness: Claims 5-6, 8, 15-16, 18, 25-26, and 28

The examiner has rejected claims 5-6, 8, 15-16, 18, 25-26, and 28 under 35 U.S.C. § 103(a) as being unpatentable over **Siegel** in view of **Okumura** (U.S. Patent Publication No. 2002/0032633) (hereinafter "**Okumura**"). This rejection is respectfully traversed.

Once again, the office action states that the rejection was *set forth in the previous office action*⁴. **Siegel** is newly cited, so previously setting forth this rejection would have been impossible. Applicants assume that the Examiner meant to state that the specific elements shown by **Okumura** were discussed in the previous action.

⁴ Office action of 06/13/2005, page 4, top of page

All of the claims in this rejection are dependent claims; their respective independent claims have been shown to be allowable, so these claims are also allowable. Further, it is noted that representative claims 5 and 6 both contain the recitation that *the registering user is a buyer and the step of identifying a matched user comprises conducting a reverse auction in which a plurality of potential sellers bid to sell the item to the registering user*, while representative claim 8 recites that *the registering user is a buyer and the registration information includes a maximum price willing that the buyer is willing to pay for the item*. Although, again, no motivation has been set forth for combining these references, Applicants assert that one would not seek to combine these two references. Okumura, like Dutta, is interested in bringing together multiple buyers with multiple sellers, while Siegel is not interested in opening the process to other sellers. It would have been against the interests of Siegel to allow other sellers to participate.

Therefore, the rejection of claims 5-6, 8, 15-16, 18, 25-26, and 28 under 35 U.S.C. § 103(a) has been overcome.

V. Claim 31

Independent claim 31 was added in a supplemental amendment close to the time that the present office action was mailed and so was not included in the office action. The examiner is thanked for taking the time to review this claim, even though no agreement was reached. Claim 31 has been further amended, both in a manner similar to the other independent claims and to recite additional distinctions of the claimed invention. The examiner's attention is particularly drawn to two specific recitations that provide further distinctions over the art relied on.

Claim 31 recites *wherein each registration includes a universal product code for a respective item, a time period for which the respective registration is valid, a condition of the respective item, and a price range specifying either a minimum selling price or a maximum buying price ... determining a search string comprising a respective universal product code and a respective price range for said new registration; searching said database for a complementary match to said new registration. ... wherein said complementary match must have a second universal product code that is identical to said respective universal product code for the new registration and an overlapping price range* (underlining added for emphasis). This ability to recite a price range increases the flexibility of the process and is not shown by the art relied on.

This claim further recites that *if a complementary match is not found, maintaining said new registration in said database while allowing said respective new user to modify said respective price range in correspondence to time spent in said database*. Again, this capability provides flexibility for the user and increases the chances that a match can be found. This recitation is not shown by the art relied on.

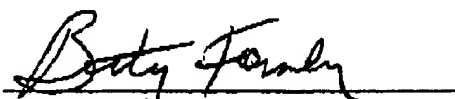
VI. Conclusion

It is respectfully urged that the subject application is patentable over the cited references and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,



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